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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,428	11/19/2003	Shingo Nozawa	00862.023313.	4216
5514 7590 06/11/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
TEKLE, DANIEL T				
ART UNIT		PAPER NUMBER		
2621				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/715,428

Applicant(s)

NOZAWA, SHINGO

Examiner

DANIEL TEKLE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Objection to Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 16-19 define a "signal can be recorded on a removable recording medium such as a magnetic tape or optical disk" (page 21 lines 7-10 of the specification). a signal" embodying that same functional descriptive is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory of 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Enari (US 5,774,624).

**Regarding Claim 1:** Enari discloses an imaging apparatus comprising: imaging means (**column 3 lines 45-46**); encoding means for encoding a moving picture signal, which has been output by imaging means, using intraframe encoding and interframe encoding, and generating an encoded image signal comprising a plurality of picture groups each comprising n (where n represents an integer equal to or greater than 2) frames of an image signal including intraframe-encoded pictures obtained by the intraframe encoding and interframe-encoded pictures obtained by the interframe encoding (**column 5 lines 34-65**); recording means for recording the encoded image signal, which has been generated by encoding means, on a recording medium (**column 1 lines 10-16**); and control means for controlling recording means in accordance with a command to start recording of the moving picture signal so as to start recording from the leading end of a picture group that contains a frame, which corresponds to the record-start command, in

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the moving picture signal that has been output from imaging means (**Fig. 5 frame 7 to frame 15**).

**Regarding Claim 2:** Enari discloses apparatus according to claim 1, wherein recording means has a memory for storing the equivalent of one picture group of the moving picture signal generated by said encoding means (**column 8 lines 41-50**).

**Regarding Claim 3:** Enari discloses apparatus according to claim 1, wherein control means further controls recording means so as to record identification-information, which indicates the frame corresponding to the record-start command, in the picture group at the portion thereof where recording starts (**Fig. 5 frame 7**).

**Regarding Claim 9:** Enari discloses apparatus according to claim 1, wherein the leading frame of each picture group is the intraframe-encoded picture (**column 5 lines 59-65**).

**Regarding Claim 10:** Claim 10 is reject for the same subject matter as claim 1, since the claim limitation is previous discussed in claim 1.

**Regarding Claim 12:** Claim 12 is reject for the same subject matter as claim 1, since the claimed limitation is previous discussed in claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Enari (US 5,774,624) as applied to claims 1-3 above, and further in view of Kitamura et al. (US 6,556,627).

**Regarding Claim 4:** Enari discloses all the limitation of claim 1 above, and Kimamura et al. discloses a transmitting means for transmitting the encoded image signal, which has been generated by encoding means, to an external device while the signal is in the encoded state (**column 10 lines 46-61**).

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Kimamura invention into Enari invention in order to transmit encoded signal into output bit stream.

**Regarding Claim 5:** Claim 5 is reject for the same subject matter as claim 4, since the claimed limitation is previous discussed in claim 1 and 4.

**Regarding Claim 6:** Enari discloses an apparatus according to claim 5, wherein control means controls encoding means and recording means in such a manner that even if the frame corresponding to the record-start command is an interframe-encoded picture, recording by recording means will be started without this frame being encoded as an intraframe-encoded picture (**column 5 lines 34-65**).

**Regarding Claim 7:** Claim 7 is reject for the same subject matter as claims 5 and 6, since the claimed limitation is previous discussed in claim 4 and 6.

**Regarding Claim 8:** Claim 8 is reject for the same subject matter as claim 4 and 6, since the claimed limitation is previous discussed in claim 4 and 6.

**Regarding Claim 11:** Claim 11 is reject for the same subject matter as claim 5, since the claimed limitation is previous discussed in claim 5.

**Regarding Claim 13:** Claim 13 is reject for the same subject matter as claim 11, since the claimed limitation is previous discussed in claim 11.

**Regarding Claim 14:** Claim 14 is reject for the same subject matter as claim 5, since the claimed limitation is previous discussed in claim 5.

**Regarding Claim 15:** Claim 15 is reject for the same subject matter as claim 11, since the claimed limitation is previous discussed in claim 11.

**Regarding Claims 16-19:** Claims 16-19 are reject for the same subject matter as claims 10-11 and 14-15, since the claimed limitation is previous discussed in claim 10-11 and 14-15 respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621  
/Daniel Tekle/  
Examiner, Art Unit 2621